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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,361	07/21/2006	Etsuo Otobe	050849	8849
23850 7590 07/09/2008 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER				
CHAKOUR, ISSAM				
ART UNIT		PAPER NUMBER		
4163				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,361

**Applicant(s)**

OTOBE ET AL.

**Examiner**

ISSAM CHAKOUR

**Art Unit**

4163

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,13-15,21-23,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,13-15,21-23,29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/12/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 1 of claim 1 recites "A telephone for displaying" but fails to state what is being displayed. Accordingly, the claim is incomplete since this essential feature is missing. Claims 3-6 inherit this deficiency.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

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Claims 23, 29, and 30 are rejected under 35 U.S.C. 101; because these claims recite a "computer program" not associated with a computer readable medium which is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 5, 6, 13, 14, 15, 21-23, 29, and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Katagishi et al (US 2002/0168997).

Regarding claim 1, 15, and 23 Katagishi discloses a telephone, a method, and a computer program for displaying, comprising:

an acquiring unit (e.g. operation unit, item 107 in figure 1) operable to acquire a telephone number of a callee region information relating to a locality of the callee (See figure1 and abstract);

a judging unit (e.g. the control unit) operable to judge (See figure 1) whether the telephone number is a telephone number satisfying a predetermined condition that enables international roaming in a telephone network of a region in a different time zone (See paragraph [0007] and paragraph [0009]);

a storage unit operable to store the telephone number, identification information

identifying the callee of the telephone number, and the region information in association with each other, based on a user operation (user operation are inputs to the operation unit as depicted in item 107 figure 1), if judged in the affirmative (See figure 15); a calculating unit (also the control unit) operable to calculate a local time of the locality shown by the region stored information, with reference to the storage unit, if a user operation selecting one of the telephone number and the identification information is performed (See figure 1 and abstract); and a display unit operable to display the local time (See item 106 in figure 1 as well as item 502 in figure 4).

2. Regarding claim 5, Katagishi teaches the telephone in accordance with claim 1, wherein the region information is recorded in a location register (e.g. VLR which controls the base-station with whom the callee communicates) that manages a movement of the telephone of the callee in a telephone network (See figure 1 and claim 5), and the acquiring unit acquires the region information by receiving the region information transmitted from the location register via the telephone network (See claim 6).

3. Regarding claim 6, Katagishi discloses the telephone in accordance with claim 5, wherein the acquiring unit acquires the region information as a reply to a callout or a request to the telephone of the callee (See abstract), and the telephone further comprises:

a reception unit operable to receive a user operation after the display of the local time, the operation being one of approving and canceling a call (See paragraph [0009], lines

8-9); and

an instructing unit operable to instruct the telephone network to one of approve and cancel the call, upon receipt of the user operation (See figure 2 & 1).

4. Regarding claim 13, 21, and 29 Katagishi teaches a telephone system and its corresponding method and computer program comprising a telephone network for managing a movement of a first telephone, and a second telephone for displaying a local time of a locality of the first telephone (See abstract),

the telephone network including:

a location registration unit (e.g. a VLR of the roaming first telephone which is inherent in roaming as discussed above) operable to record region information relating to the locality of the first telephone (See paragraph [0012] and claim3);

a reception unit operable to receive from the second telephone, specification information specifying the first telephone (claim 5); and

a notifying unit operable to notify the region information to the second telephone, upon receipt of the specification information (claim 11), and the second telephone including: an acquiring unit or operation unit operable to acquire a telephone number of the first telephone (See figure 1 and claim 1 & 10 );

a judging unit or control unit operable to judge whether the telephone number is a telephone number satisfying a predetermined condition that enables international roaming in a telephone network of a region in a different time zone (See figure 1 and claim 1 & 10 );

a storage unit operable to store the telephone number, identification information

identifying a callee of the telephone number, and the region information notified from the telephone network in association with each other, based on a user operation (user operation are inputs to the operation unit as depicted in item 107 figure 1), if judged in the affirmative (See figure 3 & 15);

a calculating unit or control unit operable to calculate the local time of the locality shown by the stored region information, with reference to the storage unit, if a user operation selecting one of the telephone number and the identification information is presented (See figure 1 and claim 1 & 6); and a display unit operable to display the local time (See item 106 in figure 1 as well as item 502 in figure 4).

5. In claim 14, 22, and 30 Katagishi teaches the telephone system and the method in accordance with claim 13 and 21 respectively. Katagishi further discloses the system wherein the reception unit receives the specification information from the second telephone as a callout request to the first telephone (See paragraph [0012]), and the telephone network further comprises:

a call unit operable to call the first telephone if a predetermined time period elapses without receiving an instruction from the second telephone after notifying the region information to the second telephone (See paragraph [0052], lines 15-18. Also depicted in the flow chart of figure 16 at step 704).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katagishi.

9. Regarding claim 3, Katagishi teaches the telephone in accordance with claim 1. Although Katagishi does not explicitly teach the telephone wherein the acquiring unit receives in an audible frequency band from a telephone of the callee a modulation signal representing the region information, and acquires the region information by decoding the received modulation signal. The modulation and demodulation of signals carrying information between mobile units at conventional frequencies bands is a technique well known in the art. It would have been obvious at the time of the invention



to have implemented this well known feature in Katagishi's system because it enables the predictable result of transmission and recovery of the desired information.

10. Regarding claim 4, Katagishi teaches the telephone in accordance with claim 1. Although Katagishi does not explicitly teach the telephone wherein the region information is transmitted from a telephone of the callee represented by an electronic mail, and the acquiring unit acquires the region information by receiving from a telephone of the callee an electronic mail in which the region information is described. Sending particular information in an electronic mail through mobile communication is a technique well known in the art; it would have been obvious at the time of the invention to have implemented this well known feature in Katagishi's system because it enables the predictable result of transmission of desired information in a well known alternative way, which IP based data communication.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka Shinichi (JP6177947) teaches obtaining information related to time and location at a receiving end. Similarly Ishii (US 2002/0098857) discloses a local clock of mobile terminals of different time zones, whereas Fujii (US 2003/0117994) discloses a method for time identification of destination portable terminal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISSAM CHAKOUR whose telephone number is (571)270-5889. The examiner can normally be reached on Monday-Thursday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Robinson can be reached on 5712722319. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IC

/Mark A. Robinson/  
Supervisory Patent Examiner, Art Unit 4163